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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,241	07/19/2001	Rod Mancisidor	WHIS1100-2	8688
25094	7590	12/10/2003	EXAMINER	
GRAY, CARY, WARE & FREIDENRICH LLP 1221 SOUTH MOPAC EXPRESSWAY SUITE 400 AUSTIN, TX 78746-6875			BOOKER, KELVIN E	
		ART UNIT		PAPER NUMBER
		2121		10
DATE MAILED: 12/10/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/909,241	MANCISIDOR ET AL.
	Examiner Kelvin E Booker	Art Unit 2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 July 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) 10,14-16 and 19 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: *Detailed Office Action*.

DETAILED ACTION

Claim Objections

1. **Claims 10, 14-16 and 19** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of previous claims. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. The claims are directed to elements of the system without disclosing any functionality [e.g., data network guidance engine, traits and values], while depending upon independent method claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Further, **claims nine and 17** provide for the use of “*performing dedicated Internet access guidance engine processing*” and “*transforming at least one crisp value of the plurality of crisp*

values”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1-20** are rejected under 35 U.S.C. 101 because the invention as disclosed in **claims one, nine and 17** are directed to non-statutory subject matter. While the claims are in the technological arts, they are not limited to practical applications in the technological arts.

Specifically, **claim one** focuses on a “dedicated Internet access guidance engine”, wherein the elements are recited in means plus function format, but the claims fail to define a statutory specific machine. A machine or manufacture or system claim may be one of two types: (1) a claim that encompasses any and every machine for performing the underlying process or any and every manufacture that can cause a computer to perform the underlying process, or (2) a claim that defines a specific machine or manufacture. When a claim is of the first type, Office personnel are to evaluate the underlying process the computer will perform in order to determine the patentability of the product.

The mere fact that a hardware element is recited in the claim does not necessarily limit the claim to a specific machine or manufacture. If a product claim encompasses any and every

computer implementation of a process, when read in light of the specification, it should be examined on the basis of the underlying process. Such a claim can be recognized, as it will define the physical characteristics of a computer or computer component exclusively as functions or steps to be performed on or by a computer, and encompass any and every product in the stated class, configured in any manner to perform the process.

Claims that define a computer related invention as a specific machine or specific article of manufacture must define the physical structure of the machine or manufacture in terms of its hardware or hardware and "specific software." The applicant may define the physical structure of a programmed computer or its hardware or software components in any manner that can be clearly understood by a person skilled in the relevant art. Generally a claim drawn to a particular programmed computer should identify the elements of the computer and indicate how those elements are configured in either hardware or a combination of hardware and specific software.

Further, **claims nine and 17** focus on a method inclusive of "*performing dedicated Internet access guidance engine processing*" and "*transforming at least one crisp value of the plurality of crisp values to a fuzzy value*", but fails to provide the steps necessary to carry out the claimed processes.

To constitutionally interpret the word "process", the Supreme Court has held that: ***A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. ***The Process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be a secondary

consequence.”(emphasis added) Diamond, Commission of Patents and Trademarks v. Diehr and Lutton, 209 USPQ 1, 6 (1981) quoting Cochrane v. Deener, 94 U.S. 780, 787-788 (1876).

This Constitutional interpretation of the word “process” is a long-standing one that the Supreme Court requires to be applied in interpreting 35 USC 101. Diamond v. Diehr at 6. Consequently, the use of that interpretation is Constitutionally required when we interpret the Federal Circuit’s standard that a “new and useful process” is one that produces a useful, concrete, and tangible result”. Cf. State Street Bank & Trust Co. v. Signature Financial Group, Inc., 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

Claims 2-8, 10-16 and 18-20 do not cure the defect in **claims one, nine and 17**. On this basis, **claims 1-20** are rejected under 35 USC 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. **Claims 1-3** are rejected under 35 U.S.C. 102(a) as being anticipated by Rigole, U.S. Patent Application Publication No. 2001/0049632 [hereafter Rigole].

As per claim 1, Rigole teaches of an expert system adapted *dedicated Internet access guidance engine*, comprising:

- A. a *dedicated Internet access guidance engine* [e.g. website processing functionality] (see page 2, paragraph [0022]: “In one possible...their identifying information”);
- B. a plurality of available Internet access products (see page 2, paragraph [0022]: “In one possible...different service providers”);
- C. customer input concerning a plurality of *dedicated Internet access guidance engine* questions, the customer input is provided to the *dedicated Internet access guidance engine* (see page 2, paragraph [0022]: “The IPCS website...pertinent service information”);
- D. the *dedicated Internet access guidance engine* uses the customer input to rate at least one available Internet access product of the plurality of available Internet access products (see page 2, paragraph [0022]; and page 6, paragraphs [0055] through [0057]; and page 7, paragraph [0063]); and
- E. the *dedicated Internet access guidance engine* selects a recommended Internet access solution, which is operable to meet a customer’s requirements, from among the plurality of available Internet access products and rated Internet access products (see page 2, paragraphs [0022] and [0023]; and page 7, paragraph [0063]: “once the automated...profile expressing interest”).

As per claim 2, Rigole teaches of an expert system wherein the *dedicated Internet access guidance engine* provides a “*recommended*” Internet access solution to an agent using a graphical user interface (see page 6, paragraphs [0055] through [0057]: generating a list based upon user-requested attributes respective of priorities (e.g., more substantially recommended results first)).

As per claim 3, Rigole teaches of an expert system wherein the *dedicated Internet access guidance engine* provides a compatible Internet access solution and a “*not recommended*” Internet access solution to the agent using the graphical user interface (see page 6, paragraphs [0055] through [0057]: generating a list based upon user-requested attributes respective of priorities (e.g., least substantially recommended results first)).

Conclusion

8. The following is prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- A. Guerin et al., U.S. Patent No. 6,243,754;
- B. Srinivansan, U.S. Patent No. 6,145,002;
- C. Lenz, U.S. Patent No. 5,784,539;
- D. Pham et al., U.S. Patent No. 5,970,482;
- E. Ahmed, U.S. Patent No. 2002/0107824;
- F. Carolan et al., U.S. Patent Application Publication No. 2002/0036658;
- G. DeFarranti et al., U.S. Patent Application Publication No. 2003/0191841;
- H. Yano, U.S. Patent Application Publication No. 2002/0052767;
- I. Carchiolo et al., “An Agent Based Platform for a Service Provider”;
- J. Caswell et al., “Using Service Models for Management of Internet Services”;
- K. McKnight et al., “Pricing Internet Services: Proposed Improvements”;
- L. Gibbens et al., “Internet Service Classes Under Competition”;

M. Semret et al., "Pricing, Provisioning and Peering: Dynamic Markets for Differentiated Internet Services and Implications for Network Interconnections";

N. Bakos, "The Emerging Role of Electronic Marketplaces on the Internet"; and

O. Johnson et al., "Consulting Without Consultants: Expert Systems Applications in User Services".

9. An inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Booker whose telephone number is (703) 308-4088. The examiner can normally be reached on Monday-Friday from 7:00 AM-5:30 PM EST.

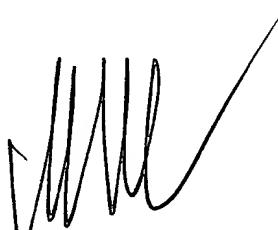
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri, can be reached on (703) 305-0282. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

K.E.B.

Art Unit 2121

December 5, 2003



ANIL KHATRI
SUPERVISORY PATENT EXAMINER